

REMARKS

Claims 1-4, 7, 8, 17-20, and 22 were examined. Claim 1 is amended without prejudice and new claims 24-31 are added. Applicants disagree with all rejections and make these claim changes only to expedite prosecution and move to allowance as soon as possible. Applicants submit that the amendments and new claims introduce no new matter. Support for the amendments and new claims can be found throughout the application as originally-filed including the original claims (see, *e.g.*, [0045] and FIGS. 5A, 5B, 8, and 9). Favorable reconsideration in light of the remarks which follow is respectfully requested.

Claims 1-4, 17-20, and 22 are rejected under 35 U.S.C. 103(a) over U.S. Patent No. 5,372,600 to Beyar et al. (hereinafter “Beyar”) in view of U.S. Patent No. 5,830,179 to Mikus et al. (hereinafter “Mikus”) and U.S. Patent No. 6,010,530 to Goicoechea (hereinafter “Goicoechea”). Claims 7 and 8 are rejected under 35 U.S.C. 103(a) over Beyar in view of Mikus and Goicoechea and further in view of U.S. Patent No. 5,645,559 to Hachtman et al. (hereinafter “Hachtman”). Of these rejected claims, only claim 1 is an independent claim. Applicants traverse, at least for the following reasons.

Claim 1 and its Dependent Claims are Allowable

Amended independent claim 1 recites, in part, “a unitarily formed coil segment defining a lumen therethrough and including a distal portion, a middle portion, and a proximal portion, the coil segment comprising a wound element including a plurality of windings spaced from each other along at least a portion of the length of the coil segment ... the coil segment being extendable lengthwise from a first length to an extended length by winding the wound element and being compressible lengthwise from the extended length by releasing the wound element.”

As indicated in paragraph [0045] of the original application, “[b]y twisting the rotatable element 510 in a first direction as shown in FIG. 9, the width of the prostatic stent 100 has decreased sufficiently to pass through the patient’s urethra without significantly irritating or bruising the walls of the patient’s urethra. As the width of the coil segment is reduced the length of the coil segment consequently extends as shown in FIGS. 5A, 5B, 8 and 9. Upon being

released from the delivery system, the coil segment 105 expands and the length contracts until the prostatic stent 100 has returned to substantially its original dimensions.”

It is asserted at page 2 of the Office action that “Beyar discloses the coil segment being extendible lengthwise from a first length to an extended length and being compressible lengthwise from the extended length, col. 4, lines 18-38.” However, Beyar only describes a stent in a stressed or torqued condition where its profile (*i.e.*, cross-sectional diameter) is reduced, and once the stent is released, the stent assumes a non-stressed, non-torqued condition with a larger diameter profile. (See, *e.g.*, column 4, lines 22-26). Beyar is completely silent with respect to the coil segment being extendible lengthwise. Beyar simply does not teach or suggest a coil segment being extendable lengthwise from a first length to an extended length by winding the wound element and being compressible lengthwise from the extended length by releasing the wound element as recited in Applicants’ amended independent claim 1.

Mikus does not remedy this deficiency. Mikus describes a stent made of a memory shape alloy with a low temperature martensite state and a high temperature austenite state. The stent is used to heat the prostate gland and is left in the urethra while the prostate heals. After the prostate is substantially healed, the stent is cooled to its martensite state and is easily removed from the urethra (see, *e.g.*, Abstract). There is simply no teaching or suggestion at all in Mikus of varying the length of a stent by winding a wound element.

Goicoechea also does not remedy this deficiency. Goicoechea also describes a stent made of a memory shape alloy with a low temperature martensite state and a high temperature austenite state. When cooled in ice water to a temperature below the martensitic transformation temperature of the stent, the device is compressed to a reduced diameter and inserted into an introducer. After the introducer is inserted into the vasculature to the desired location, the stent is discharged out of the introducer and exposed to body temperature, which is above the austenitic temperature and the stent expands. (See, *e.g.*, column 6, lines 52-58 and column 7, lines 5-9). Thus, Goicoechea does not teach or suggest a coil segment being extendable lengthwise from a first length to an extended length by winding the wound element and being compressible lengthwise from the extended length by releasing the wound element.

Accordingly, amended independent claim 1 is patentable over Beyar, Mikus, and Goicoechea. Claims 2-4, 7, 8, 17-20, and 22 depend either directly or indirectly from claim 1 and, thus, also are patentable over Beyar, Mikus, and Goicoechea. The secondary reference (*i.e.*, Hachtman) is used in the action only to reject dependent claims 7 and 8 and only in combination with Beyar, Mikus, and Goicoechea. Applicant submits that those dependent claim rejections must necessarily be overcome given that the main references (*i.e.*, Beyar, Mikus, and Goicoechea) have been distinguished and overcome.

New Claim 24 and its Dependent Claims are Allowable

New claim 24 recites, in part, “a plurality of windings spaced from each other along at least a portion of the length of the coil segment and being reducible in width at least to an extent needed to pass the stent into the body lumen of the patient by winding the wound element, the coil segment being extendible lengthwise from a first length to an extended length as the width of the coil segment is reduced by winding the wound element.” For similar reasons as discussed above for claim 1, new claim 24 is also allowable over the art of record. Based at least upon their dependence from claim 24, claims 25-31 are also allowable.

Accordingly, it is respectfully submitted that the present application is now in condition for allowance. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

Prompt and favorable consideration of this Amendment is respectfully requested.

Dated: SEPTEMBER 16, 2009

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